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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,486	08/31/2000	James J. Crow	BRO039/4-001	4808

7590 05/20/2004

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EXAMINER	
ALAM, UZMA	

ART UNIT	PAPER NUMBER
2157	7

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/653,486	Applicant(s) CROW, JAMES J.
	Examiner Uzma Alam	Art Unit 2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☒ Claim(s) *5* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 August 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to the amendment filed on March 8, 2004. Claims 1-33 are pending. Claims 1-33 represent system, method and control software for provisioning a personal computer with broadband service.

Response to Arguments

Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claim 5 is objected to because of the following informalities:

The limitation "qualifying step" should be preceded by the word "said."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 7, 9, 9-13, 17-24 and 28-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al. US Patent No. 6,636,505. Wang discloses the invention substantially as claimed including a method for automatically provisioning a broadband communication service (see abstract).

As per claims 1, 11, and 21 Wang discloses the method, system and control software of converting a personal computer for

communicating information on a broadband communication network, said personal computer having a user and a physical location, comprising:

determining whether said physical location falls within a set of service boundaries for said broadband communication network (checking location of client and if service is available at that location; column 4, lines 53-60; column 5, lines 20-30; column 10, lines 63-67; column 11, lines 1-7);

if said physical location falls within said service boundaries, electronically offering said user access to said broadband communication network (sending client offer of broadband service; column 5, lines 20-30; column 11, lines 7-35);

receiving from said user an electronic order accepting said offer (user responds with an OK; column 5, lines 20-30; column 6, lines 25-32);

remotely qualifying said personal computer for said broadband communication network by determining whether said personal computer meets predetermined acceptance criteria for use of said broadband communication network (checking client system for compatibility with broadband network; column 6, lines 66-67; column 7, lines 1-15, lines 33-67; column 8, lines 1-41, lines 64-67; column 9, lines 1-11); and

fulfilling said order by initiating an automation agent on said personal computer to interact with a user and thereby configure said personal computer for access to said broadband communication network (configuring client to use the broadband network/ column 5, lines 20-67; column 6, lines 1-65).

As per claims 2, 12, and 23 Wang discloses the conversion method, system and control software of claims 1, 11, and 21 wherein said broadband communication network is a DSL network (column 6, lines 4-12).

As per claims 3, 13, and 24 Wang discloses the conversion method, system and control software of claims 2, 12, and 23 wherein said qualifying step further comprises using a narrowband modem to contact a DSL line qualification server to test a physical line outside of said broadband communication network (column 5, lines 49-65).

As per claims 7 and 17, Wang discloses the conversion method and system of claims 1 and 11 wherein said user is selected for said offer based on preestablished criteria (column 5, lines 54-65).

As per claim 8, Wang discloses the conversion method of claim 6, wherein at least some of said criteria are stored in a subscriber profile database (column 9, lines 36-55).

As per claims 9, 19, and 28 Wang discloses the conversion method, system and control software of claims 1,11, and 22 wherein said broadband communication network is an ISDN network (the network includes a fiber optic network; column 6, lines 4-12)

As per claims 10, 20, and 29, Wang discloses the conversion method, system and control software of claim 1, 11, and 22 wherein said broadband communication network is a wireless network (column 6, lines 4-12)

As per claim 18, Wang discloses the conversion method of claim 17, wherein at least some of said criteria are stored in a subscriber profile database (column 9, lines 36-55).

As per claim 30, Wang discloses a method comprising:

remotely determining whether a personal computer is coupled to hardware needed to communicate via a broadband communication network(checking client system for compatibility with broadband network; column 6, lines 66-67; column 7, lines 1-15, lines 33-67; column 8, lines 1-41, lines 64-67; column 9, lines 1-11); and

in response to determining that said personal computer is coupled to said hardware, initiating an automation agent on said personal computer to configure said personal computer to communicate via said broadband communication network (configuring client to use the broadband network/ column 5, lines 20-67; column 6, lines 1-65).

As per claim 31, Wang discloses the method of claim 30 wherein

the remotely determining is performed in response to all electronic order for a service provided via the broadband communication network (sending client offer of broadband service; column 5, lines 20-42; column 11, lines 7-35).

As per claim 32, Wang discloses the method of claim 30 wherein the remotely determining is performed in response to a narrowband connection between said personal computer and an automation server (column 5, lines 49-65).

As per claim 33, Wang discloses Control software for configuring a personal computer for communicating over a broadband network, said control software comprising:

a first module to determine whether said personal computer is coupled to hardware needed to communicate via said broadband communication network(checking client system for compatibility with broadband network; column 6, lines 66-67; column 7, lines 1-15, lines 33-67; column 8, lines 1-41, lines 64-67; column 9, lines 1-11); and

a second module to configure said personal computer to communicate via said broadband communication network(configuring client to use the broadband network/ column 5, lines 20-67; column 6, lines 1-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-6, 8, 14-16 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. US Patent No. 6,636,505 in view of Bahlman US Patent No. 6,684,242. Bahlmann discloses the invention substantially as claimed including a method for preparing a computer for service activation with a network service provider (see abstract).

As per claims 4, 14, and 25 Wang discloses the conversion method, system and control software of claims 1, 11, and 22. Wang does not explicitly disclose wherein said broadband communication network is a cable network. Bahlmann discloses a cable network. See column 3, lines 37-48. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the cable network of Bahlmann with the broadband network of Wang. A person of ordinary skill in the art would have been motivated to do this so that the network can be used with user premise equipment.

As per claims 5, 15, and 26 Wang and Bahlmann disclose the conversion method, system and control software of claims 4, 14, and 25 wherein qualifying step further comprises detecting a carrier signal from said broadband communication network (Wang; column 6, lines 13-33).

As per claims 6, 16, and 27, Wang and Bahlmann disclose the conversion method, system and control software of claims 5, 15, and 26 wherein said carrier signal has a signal strength and a set of error codes, and wherein said qualifying step is based at least part upon said signal strength and said error codes (Wang column 9, lines 1-11).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sundaresan et al. U.S. Patent No. 6,463,079 discloses a system for processing orders for high bandwidth connections.

Gilles et al. U.S. Patent No. 6,249,578 discloses a system and method for exchanging telecommunication service information.

Hamilton U.S. Patent No. 5,852,722 discloses a distributed computer network comprising unconfigured network home client computers.

Brodigan U.S. Patent No. 6,289,381 discloses a broadband communication system with a host terminal and network interface.

Gidwani U.S. Patent No. 6,640,239 discloses an intelligent scalable switching network.

Dieterman et al. U.S. Patent No. 6,560,704 discloses method for updating computer configuration settings.

St. Pierre et al U.S. Patent No. 5,901,352 discloses system for enabling network convergence.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uzma Alam whose telephone number is (703) 305-8420. The examiner can normally be reached on Monday-Tuesday 11:30am-8pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308 - 7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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